



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/673,050

09/26/2003

Gardner G. Courson

250-0002US

8057

29855

7590

02/25/2008

WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,
L.L.P.

20333 SH 249

SUITE 600

HOUSTON, TX 77070

EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

02/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/673,050
Filing Date: September 26, 2003
Appellant(s): COURSON ET AL.

Keith Lutsch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 8, 2007 and May 11, 2007
appealing from the Office action mailed September 7, 2006.

Art Unit: 3629

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is substantially correct.

On May 8, 2007, Darlene Brown mailed a Notification of Non-Compliant Appeal Brief to appellant stating that the summary of claimed subject matter section does not map the independent claims to the specification.

In response, the appellant filed the following:

The Summary of Claimed Subject Matter portion of the Appeal Brief includes sections that start "One aspect claimed," "A second aspect claimed" and "A third aspect claimed." These sections correspond to the three independent claims 1, 5 and 8 exactly and include proper mapping to the specification and figures. Therefore it is respectfully submitted that Applicants' Appeal Brief is fully compliant with the requirements and no amendment or correction is required.

From appellant's description, the Examiner asserts that the "one aspect claimed" corresponds to independent claim 1, the "second aspect claimed" corresponds to independent claim 5 and the "third aspect claimed" corresponds to independent claim 8.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is essentially correct.

The Examiner ***withdraws*** the rejection of ***claims 1-4 only*** under 35 U.S.C. 112, 1st paragraph, as failing the enablement requirement.

However, the Examiner ***maintains*** the rejection of claims 5-12 under 35 U.S.C. 112, 1st paragraph, as failing the enablement requirement.

The Examiner ***withdraws*** the rejection of claims 5-12 under 35 U.S.C., 1st paragraph stating that the claimed invention is not supported by a specific asserted or well established utility.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 is directed to a tool for recommending a decision in litigation. The Examiner is interpreting this to be a decision regarding litigation. Claim 5 discloses weighting values with each element and an analyzer using the stored information and the values to determine a resultant value and a recommendation element using the determined resultant value to an associated decision option to provide a recommended decision.

The Examiner asserts that the specification fails to provide an sufficient guidance and direction to enable one skilled in the art to make or use appellant's invention without undue experimentation.

The appellant discloses:

Art Unit: 3629

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0014] Additionally, the tool directs counsel to assign values to reflect the importance of various aspects of the litigation. Based on (1) ***the values that are assigned, (2) counsel's assessment of the particular aspect of the litigation which is captured through the yes/no queries mentioned above, and (3) statistical assessments of likely outcomes*** based on historical records of previously captured information and analogous assessments, the tool provides counsel with suggested paths forward.

[0015] This process will occur on both a step by step basis as well as with an overall assessment of the case. ***Through this multi-step process, counsel, in cooperation with the client, analyze the strengths and weaknesses of the case and determines the appropriate path forward.*** This process is conducted in cooperation with other counsel involved in the case in order to reduce costs and to promote efficiency.

The instant specification discloses assigning values to reflect the importance of various aspects of the litigation and a statistical assessment of likely outcomes based on historical records [0014]. However, the Examiner asserts that the actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one skilled in the art would know what the values are or how to assign them. Appellant has not disclosed what the values are or what they represent. How does one skilled in the art go about weighting values? How does an analyzer determine a resultant value? What is an analyzer? The term analyzer is not defined in the specification and identified in the drawings. Is it a person or software? The instant specification does not disclose any equation used to determine the resultant values. Without knowing what the values are or how to

Art Unit: 3629

weight the values, or how the resultant value is determined, the Examiner asserts that one skilled in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value. Thus, the Examiner asserts that appellant's invention is not capable of providing a predictable or repeatable result as required by statute with undue experimentation.

Appellant's specification further discloses:

[0031] It is, of course, necessary to enter data and that is done by going to a task screen 312 shown in FIG. 5. In the left hand column of the illustrated screen 312 it is noted that there are a series of tasks which need to be performed, including review of the complaint; doing a venue and business analysis, issuing a FOIA request; requesting other agency documentation; doing a locus determination; a court admission evaluation; analysis of the local rules; any legal research necessary; an early evaluation of the discovery; a jury venire; removal analysis, which will be discussed in more detail below; responsive pleading requirements, which is also discussed in more detail below; transfer analysis and early case assessment. Each of these are task and data gathering steps to help develop recommendations. ***The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field.***

[0033] FIGS. 6-10 are screen shots illustrating the venue/business analysis questions. As can be seen, there are a series of questions relevant to determining venue for the particular case and doing a business analysis to see the business factors of the case. ***As to each particular question, an assessment value is provided as shown in FIG. 10.*** For example, particular assessments are such as strongly favors defendant, favors defendant, no effect, favors plaintiff and strongly favors plaintiff. ***These assessments are then weighting values that are entered for each particular question.*** The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool. A recommendation could be presented, but is not shown in the exemplary embodiment. Generally, this particular set of questions would be entered by a lawyer, rather than a legal assistant, as generally some experience is required for these particular questions.

Art Unit: 3629

[0035] FIGS. 19 through 22 illustrate the exemplary screens used for the removal analysis. For example, there are questions as to whether it was a state or federal court filing, and if it was a state court filing, if there was a basis for removal, what type of jurisdiction and so on. Further, there are a series of decision points that must also be made and these are selected from a list as shown in FIG. 22, which can include strongly favors removal, favors removal, no effect in removal, favors remaining in state and strongly favors remaining in state. **Again, these particular selections of the decision values are used in a weighting analysis to determine whether to provide the removal recommendation.** It is further noted that under each particular category of decision is an analysis block so that the user can indicate the particular thought process used to develop the particular indicated decision. This allows review by more experienced parties, associates or more skilled partners for example, without requiring the actual in person presence of the particular user that entered the data.

[0036] **It is noted on FIG. 21 that a recommendation value is provided.** It is understood that the particular data is entered as described above. **Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer.** Using screens not shown, **experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation.** Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers. In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

[0037] **Based on the results of the weighted analysis and review or comparison to similarly situated cases, a recommendation is provided by the tool.** In the illustration of FIG. 21, the recommendation is to Remove.

Art Unit: 3629

Although not shown in FIG. 21, it would also be appropriate to include the percentage values of data collection and reliability to go with the particular recommendation value to allow a quicker evaluation of the recommendation value.

[0038] FIGS. 23-28 are exemplary screen shots of the responsive pleading task. In this instance, the decision to be made is to answer, dismiss or move for a more definite statement. Within the right-hand side of each of the screen shots are percent complete, reliability and recommendation values. Also shown in FIG. 23 are the determinations necessary to develop the recommendation. A series of questions are provided with entry locations to determine the amount of time and/or dollars necessary to perform the indicated task. These time and/or dollar values are then used to develop an approximate cost for an answer. It is noted that an answer is always accepted by the court and therefore there is no need to do an analysis on the probability of success. FIG. 26, on the other hand, shows a motion to dismiss exemplary screen shot. It is noted on the bottom of the screen there are entry values for the particular times and/of costs for the particular tasks to develop a cost for this alternative. Above that are a series of questions that have drop down or selection boxes to allow the user to select particular answers for each question. ***Appropriate values for each particular question are incorporated into the drop down list and are assigned particular numerical values. The numerical values for each of the particular answers is then used in a weighted analysis to determine probability of success,*** which is then coupled with the cost to develop a probabilistic value, which is then compared with the cost of an answer and the cost of a motion for more definite statement. The questions and task entries for a more definite statement are shown on FIG. 27. When entries have been made for all of the particular values, a complete recommendation can be made. In addition, as data is entered, the percentage completed and reliability numbers are updated so that not necessarily all data needs to be provided to reach a certain level of confidence in the particular recommendation. In the illustrated example the recommendation is to Answer rather than to move to dismiss or for more definite statement. The weighting and probability values are entered as previously described. For the particular responsive pleading analysis, the data values could be entered by a combination of attorneys and legal assistants.

The appellant has identified an invention which requires a user to input information into a computer wherein many of the values are provided by the subjective analysis of the user, an attorney and/or a client. Because the values are subjective, for a single situation, there could be different results based on the

subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

Thus, the Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

Claim 5 is directed to a recommendation element using the determined resultant value and the associated decision option to provide a recommended decision. What is a recommendation element? It is not defined in the disclosure or identified in the drawings. How is the recommendation decision made using the determined resultant value and the associated decision options? As set forth above, the specification does not describe how this recommended decision is made in such a way as to enable one skilled in the art to make or use the invention without undue experimentation.

Claim 6 states that an analyzer and said recommendation element utilize said collected results to develop a resultant value or recommended decisions. As set forth

Art Unit: 3629

above, the specification does not describe or provide guidance as to the elements of the step or how to perform this step, i.e., determining the resultant value or recommended decision, in such a way as to enable one skilled in the art to make or use the invention. (Moreover, the Examiner notes that the appellant states that the invention is directed to an apparatus, not a method)

Claim 8 states that an assessment is provided. The specification does not describe how the assessment is performed or what goes into the assessment in such a way as to enable one skilled in the art to make or use the invention without undue experimentation.

Claims 9-12 identify a statistical decision tree. The specification does not describe how to develop the decision tree in such a way as to enable one skilled in the art to make or use the invention without undue experimentation.

As for the statistical decision tree, the specification discloses:

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. ***The tool provides a decision tree structure underlying the various steps*** of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0036] It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer. Using screens not shown, experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the

Art Unit: 3629

score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against **a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers.** In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

The appellant has not clearly defined the decision tree in the specification. There is no guidance as to how one skilled in the art would go about developing a statistical decision tree or what input goes into the development of the statistical decision tree so as to produce repeatable and predictable results without undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the appellant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

It is not clear what statutory class the invention falls into. The appellant simply identifies the invention as a tool. However, there is no clear structure identified and there are no clear method steps. For example, claim 1 identifies the invention as

Art Unit: 3629

comprising an entry field, a menu, storage of discovery related information, form discovery materials, and a discovery production mechanism. A menu and form materials are clearly are not proper structure for an apparatus, but are written data instead.

Claim 5 is directed to a tool for recommending a decision in litigation comprising interfaces, storage, weighting values, an analyzer, resultant values and a recommendation element. Weighting values appears to be a method step. Resultant values are not structure. Interfaces can be software. Therefore, it is unclear what statutory class the appellant's invention resides in.

Claim 8 is directed to a tool for assessing a litigation comprising a plurality of tools, interfaces, storage, and an assessor. The appellant fails to define an assessor is in the specification or identify it in the drawings.

What does the appellant mean by "a tool"?

NOTE: The appellant defines "a tool" in the arguments submitted on June 21, 2006 as something (**as an instrument or apparatus**) used in performing an operation or necessary in practice of a vocation or profession).

The Examiner asserts that this is still indefinite. Something can be anything. An instrument can be a document.

What does the appellant mean by the following language in claim 1 – *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

What does the appellant identify as an analyzer? This is not defined in the specification or identified in the drawings.

Claim 8 identifies the invention as “a tool”. However, the body of the claim language states that there are a plurality of tools according to claim 5. This is unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. It is not clear what statutory class the appellant's invention would fall into. The appellant identifies the invention as a tool. However, there does not appear to be sufficient structure identified for an apparatus/system. For example, in claim 1, the appellant states that the tool comprises an entry field, a menu, form discovery materials and a discovery production mechanism. Thus, the invention is not clearly a machine/apparatus or system. The appellant does not clearly define method steps although such language as set forth in claim 1 could be construed to be a method step (storage of discovery related information gathered from said menu). Resultant values and weighting values are clearly not structure. Therefore, the invention does not clearly fall into the statutory class of process or method. It is not

an article of manufacture or a composition of matter. Therefore, the invention appears to be non-statutory.

NOTE: In appellant's remarks submitted with the amendment filed on June 21, 2006, appellant states that the claims are properly classified as apparatus or system claims. The appellant states that the present claims are a combination of graphical user interface elements and related data fields, physical storage, stored information, and a generally computer implemented process (page 9). Stored information is not structure. Data fields are not structure. (The Examiner notes that the appellant's claim language only claims interfaces, not graphical user interfaces).

Claim 5 is directed to a tool comprising interfaces, storage, weighting values, an analyzer, resultant values, and a recommendation element. Weighting values appears to be a method step. Resultant values is not structure or a method step. It is unclear what a recommendation element is or what an analyzer is.

Claim 8 is a tool comprising a plurality of tools, interfaces, storage, and an assessor. Once again, it is unclear what statutory class of the invention would fall into.

Furthermore, although appellant states that the tool is an apparatus, it is not clear that the tool is not software or a web site or web pages. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware.

According to common definitions and barring any "special definition" in an application, web sites or web pages are *files or documents*, not the computer or network hardware that makes available or presents these files. The MPEP gives us guidance on

how to deal with files or documents at MPEP 2106 IV B 1 (a) and (b), under the headings of "functional descriptive material" and "nonfunctional descriptive material".

If the files or documents are data structures or computer executable code, they are statutory if they are embodied on a computer-readable medium, provided of course they provide a useful, concrete and tangible result. If the files or documents are nonfunctional descriptive material, e.g. music, photographs, compilations of data, such material cannot exhibit any functional interrelationship with the way in which computing processes are performed and would not be statutory. This is true even if the nonfunctional descriptive material is embodied on a computer-readable medium.

Claims 5-12 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.

In the present case, the values are subjective. As set forth by appellant in the abstract, the tool provides a framework that captures the judgment of seasoned practitioners. Furthermore, the decision tree identified in claims 9-12 is developed with input from experienced lawyers. Thus, because the values and input are subjective, for a single situation, there could be different results (score translated into a recommendation) based on the subjective determination of the user. Therefore, the appellant's invention is not capable of providing concrete results as required by 35

U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

NOTE: The Examiner finds that because claim(s) 1-12 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied *as much as practically possible*.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Newell et al (US 2003/0112270) (hereinafter referred to as Newell).

Referring to Claim 1:

Newell discloses a tool for developing litigation discovery materials, comprising:

an entry field (Figure 1a (103), [0056];

a menu (Figure 3A);

storage ([0024-0029];

forms (Figure 3B-2 Common Case Forms);
production mechanism [0100].

Referring to Claims 2-4:

Newell discloses the menu includes information relating to discovery type and party [0030-0031].

Referring to Claims 5-12:

Newell discloses a tool for aiding in litigation, comprising:
interfaces [Figure 1a (103)] ;
storage [0024-0029];
an analyzer (processor unit 112).

(10) Response to Argument

A. Section 112, 1st paragraph, Enablement

The Examiner rejects claims 5-12 stating that the claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because the claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 is directed to:

A tool for recommending a decision in litigation, the tool comprising:
interfaces for gathering selected information relevant to the decision;
storage for the gathered selected information;
weighting values associated with each element of selected information;

Art Unit: 3629

an analyzer for using the stored selected information and the associated weighting values to determine a resultant value;

resultant values associated with various decision options; and

a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

Claim 8 is directed to:

A tool for assessing a litigation, comprising:
a plurality of tools according to claim 5, each tool for a decision in the litigation;
interfaces for gathering further selected information relevant to the litigation;
storage for the further selected information; and

an assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment.

Claim 5 is directed to a tool comprising interfaces, storage, weighted values, an analyzer, resultant values and a recommendation element. Claim 5 is directed to associating weighting values with each element and an analyzer using the stored information and the associated weighted values to determine a resultant value, said resultant values associated with various decision options, and a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

Claim 8 is directed to a tool comprising a plurality of tools, interfaces, storage and an accessor. Claim 8 discloses an accessor utilizing the decisions of each of the plurality of tools for providing an assessment relating to litigation.

At the onset, the Examiner notes that neither the term “analyzer” nor the term “accessor” are identified in the body of the specification or any of the drawings. The only place that these terms are found are in the claim limitations.

The Examiner asserts that the specification fails to provide sufficient guidance and direction to enable one skilled in the art to make or use the invention without undue experimentation.

For example, the appellant’s specification discloses:

(ABSTRACT) A tool which provides counsel with a data collection mechanism to guide them through various steps in the litigation process and directs counsel and/or legal assistants to determine what information is required. The tool provides a "Discovery Generator" that is available to capture counsel's potential discovery requests, which are linked to existing document and form production tools for facilitated production of discovery. The tool informs the user of the percentage of progress of the required information that has been entered. The tool provides ***an analytical framework that captures the judgment of seasoned practitioners to provide a comprehensive analysis of the legal, factual, and business aspects of the lawsuit. The tool provides methodologies that quantify subjective analyses through the use of weighted measuring schemes.*** The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to queries to aid in the capture and analysis of information. To do this the tool directs counsel to assign values to reflect the importance of various aspects of the litigation. Based on the values that are assigned, counsel's assessment of the particular aspect of the litigation which is captured through the queries mentioned above, and statistical assessments of likely outcomes based on historical records of previously captured information and analogous assessments, the tool provides counsel with suggested paths forward. This process occurs on both a step by step basis as well as with an overall assessment of the case.

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

Art Unit: 3629

[0014] Additionally, the tool directs counsel to assign values to reflect the importance of various aspects of the litigation. Based on (1) ***the values that are assigned, (2) counsel's assessment of the particular aspect of the litigation which is captured through the yes/no queries mentioned above, and (3) statistical assessments of likely outcomes*** based on historical records of previously captured information and analogous assessments, the tool provides counsel with suggested paths forward.

[0015] This process will occur on both a step by step basis as well as with an overall assessment of the case. ***Through this multi-step process, counsel, in cooperation with the client, analyze the strengths and weaknesses of the case and determines the appropriate path forward.*** This process is conducted in cooperation with other counsel involved in the case in order to reduce costs and to promote efficiency.

The Examiner asserts that the instant specification discloses assigning values to reflect the importance of various aspects of the litigation and a statistical assessment of likely outcomes based on historical records [0014]. However, the actual values used or how the values are assigned or weighted has not been sufficiently disclosed so that one skilled in the art would know what the values are or how to assign them. Appellant has not disclosed what the values are or what the values represent. How does one skilled in the art go about weighting or assigning these values? How does an analyzer determine a resultant value using the stored selected information and the associated weighting values? What defines an analyzer? As set forth above, the appellant has not defined or identified the term "analyzer" in the specification or the drawings. The instant specification does not disclose an equation used to determine the resultant values. There is no guidance or direction as to how these resultant values are associated with various decision options. Without knowing what the values are or how to weight or assign the values, or how the resultant value is determined, one skilled in the art would simply be left to guess what the values are,

how to assign them, and how to determine a resultant value which is used to provide a recommended decision.

Appellant's specification further discloses:

[0031] It is, of course, necessary to enter data and that is done by going to a task screen 312 shown in FIG. 5. In the left hand column of the illustrated screen 312 it is noted that there are a series of tasks which need to be performed, including review of the complaint; doing a venue and business analysis, issuing a FOIA request; requesting other agency documentation; doing a locus determination; a court admission evaluation; analysis of the local rules; any legal research necessary; an early evaluation of the discovery; a jury venire; removal analysis, which will be discussed in more detail below; responsive pleading requirements, which is also discussed in more detail below; transfer analysis and early case assessment. Each of these are task and data gathering steps to help develop recommendations. ***The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field.***

[0033] FIGS. 6-10 are screen shots illustrating the venue/business analysis questions. As can be seen, there are a series of questions relevant to determining venue for the particular case and doing a business analysis to see the business factors of the case. ***As to each particular question, an assessment value is provided as shown in FIG. 10.*** For example, particular assessments are such as strongly favors defendant, favors defendant, no effect, favors plaintiff and strongly favors plaintiff. ***These assessments are then weighting values that are entered for each particular question.*** The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool. A recommendation could be presented, but is not shown in the exemplary embodiment. Generally, this particular set of questions would be entered by a lawyer, rather than a legal assistant, as generally some experience is required for these particular questions.

[0035] FIGS. 19 through 22 illustrate the exemplary screens used for the removal analysis. For example, there are questions as to whether it was a state or federal court filing, and if it was a state court filing, if there was a basis for removal, what type of jurisdiction and so on. Further, there are a series of decision points that must also be made and these are selected from a list as shown in FIG. 22, which can include strongly favors removal, favors

removal, no effect in removal, favors remaining in state and strongly favors remaining in state. ***Again, these particular selections of the decision values are used in a weighting analysis to determine whether to provide the removal recommendation.*** It is further noted that under each particular category of decision is an analysis block so that the user can indicate the particular thought process used to develop the particular indicated decision. This allows review by more experienced parties, associates or more skilled partners for example, without requiring the actual in person presence of the particular user that entered the data.

[0036] ***It is noted on FIG. 21 that a recommendation value is provided.*** It is understood that the particular data is entered as described above. ***Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer.*** Using screens not shown, ***experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation.*** Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers. In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

[0037] ***Based on the results of the weighted analysis and review or comparison to similarly situated cases, a recommendation is provided by the tool.*** In the illustration of FIG. 21, the recommendation is to Remove. Although not shown in FIG. 21, it would also be appropriate to include the percentage values of data collection and reliability to go with the particular recommendation value to allow a quicker evaluation of the recommendation value.

[0038] FIGS. 23-28 are exemplary screen shots of the responsive pleading task.

In this instance, the decision to be made is to answer, dismiss or move for a more definite statement. Within the right-hand side of each of the screen shots are percent complete, reliability and recommendation values. Also shown in FIG. 23 are the determinations necessary to develop the recommendation. A series of questions are provided with entry locations to determine the amount of time and/or dollars necessary to perform the indicated task. These time and/or dollar values are then used to develop an approximate cost for an answer. It is noted that an answer is always accepted by the court and therefore there is no need to do an analysis on the probability of success. FIG. 26, on the other hand, shows a motion to dismiss exemplary screen shot. It is noted on the bottom of the screen there are entry values for the particular times and/of costs for the particular tasks to develop a cost for this alternative. Above that are a series of questions that have drop down or selection boxes to allow the user to select particular answers for each question. ***Appropriate values for each particular question are incorporated into the drop down list and are assigned particular numerical values. The numerical values for each of the particular answers is then used in a weighted analysis to determine probability of success***, which is then coupled with the cost to develop a probabilistic value, which is then compared with the cost of an answer and the cost of a motion for more definite statement. The questions and task entries for a more definite statement are shown on FIG. 27. When entries have been made for all of the particular values, a complete recommendation can be made. In addition, as data is entered, the percentage completed and reliability numbers are updated so that not necessarily all data needs to be provided to reach a certain level of confidence in the particular recommendation. In the illustrated example the recommendation is to Answer rather than to move to dismiss or for more definite statement. The weighting and probability values are entered as previously described. For the particular responsive pleading analysis, the data values could be entered by a combination of attorneys and legal assistants.

The Examiner asserts that the appellant has identified an invention which requires a user to input information into a computer wherein many of the values are provided by the subjective analysis of the user. As set forth in appellant's specification, the invention is directed to a tool that provides an analytical framework that captures the judgment of seasoned practitioners to provide a comprehensive analysis of the legal, factual, and business aspects of a lawsuit (abstract). The tool directs the attorney to assign values to reflect the importance of various aspects of

the litigation. Based on the values that are assigned and the attorney's assessment of particular aspects of the litigation and statistical assessments of likely outcomes based on historical records previously captured and analogous assessments, the tool provides the attorney with suggested paths. Through this process, counsel, in cooperation with the client, analyze the strengths and weaknesses of a case and determine the appropriate path forward [0014-0015]. The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field [0031]. Appellant discloses that each of the data values includes a particular value which is used in a weighted analysis as derived by an experienced lawyer. Experienced lawyers provide weighting factors for each particular data value. These weighting values are then combined to form a score which is then translated into a recommendation [0036].

The Examiner notes that appellant's invention takes the subjective input of a user and enters it into the computer to produce a recommendation. The Examiner asserts that because the values are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. As set forth above, appellant's invention is a tool that provides a framework that ***captures the judgment of***

seasoned practitioners. The actual weighting values are **based on assessments of criticality for each particular response as determined by skilled and experience lawyers.** This actual data gathered is used in a weighted manner to determine a recommendation.

The Examiner asserts that the appellant does not provide sufficient guidance or direction as to an actual numerical value being used or how the value is assigned or weighted. As set forth above, the invention aggregates a user's judgment and condenses the judgment into a recommendation. It is unclear from the disclosure how a computer would be programmed, without undue experimentation, to provide a value and assign or weight the value in order to take into account all of the subjective answers which the process entails. Although the instant specification is replete with generalizations regarding the values, it is short on any specific direction or guidance as to what the values actually are or how they are assigned or weighted. It is the subjective nature of appellant's input into the computer and the lack of guidance and direction as to the meaning and application of values that raises the question of enablement. The Examiner asserts that it is the subjective analysis and judgments utilized to apply undefined values that prevents the invention from producing a repeatable and predictable result without undue experimentation.

Therefore, the Examiner asserts that the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the

invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

The appellant states in the Appeal Brief that the illustrated embodiments utilize weighted analysis values to form a score, with the score transmitted to a recommendation. The appellant further states that the end result of the tool is a recommendation and that any numerical values utilized in the analysis process are internal to the tool itself and used in the internal calculations and analysis. Appellant contends that as such, those numerical values need not necessarily have a specific meaning to a person in the industry. Appellant asserts that it is sufficient that they [the values] have a range and that the range is known so that scores can be converted to recommendations. Appellant states that the actual numerical values would likely vary based on the specific analysis techniques utilized in any event, so again absolute meaning of the specific numeric values is not necessary. Appellant asserts that once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then and is not required to be defined with respect to the outside environments in any event.

Appellant then gives the following example (pages 12-13 of the Appeal Brief):

As an example, consider a series of different surveys. In some cases a ranking of 1 to 5 will be requested. In some of these instances 1 will be high while in others 5 will be high. Other surveys may be 1 to 3 or 1 to 10 or A to E. ***The actual numerical values are irrelevant.*** What is relevant is the relationship defined for the particular survey, which then operates on its own defined values. This survey example indicates the values only have defined meanings within the

Art Unit: 3629

context of the survey itself, not some universally known value as apparently required by the rejection.

Appellant argues that the rejection next questions the weighting values.

Appellant states that:

Applicants quote from ¶ 31: "the actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field." This is further described in ¶ 36, though the term weighting factors is used. Applicants submit this is extremely clear.

The Examiner asserts that while this statement is extremely clear, the claimed invention is not capable of producing a concrete result, i.e., a predictable and reproducible result without undue experimentation due to the lack of guidance and direction provided by appellant as to what these weighted values are or how they are applied. The fact that the actual ***weighting values are based on assessments of criticality*** for each particular response ***as determined by skilled and experienced lawyers*** in the field is further evidence that the invention is not enabled due to quantity of experimentation needed to make and use the appellant's invention so that it provides a predictable and repeatable result as required by statute. The Examiner asserts that assessments by skilled and experienced lawyers are not repeatable nor predictable.

Appellant states that the Examiner next questions how the analyzer determines a resultant value. In response, appellant states:

Applicants quote from ¶ 36: "the weighting values are then combined to form a score, which is then translated into a recommendation."

In response to the Examiner's question as to how they [the weighted values] are combined, the appellant states:

Again that is relevant only to the internal operation of the tool, as the score is then translated into a recommendation. This is clear in the next sentence in ¶ 36: "Again, ***experienced lawyers would select the scores for a particular recommendation.***"

In response to the Examiner's question of what defines an analyzer, is it a person or software, the appellant states that:

As the claimed invention is a tool, it is extremely clear that the analyzer is software. See ¶ 29: "Fig. 2 illustrates an exemplary computer system for operating a tool according to the present invention" and "In the preferred embodiment the actual tool runs as a series of Java applications loaded from the server 200 by certain runtime pieces that are installed locally on the workstation 206."

The Examiner asserts that as set forth in appellant's specification, it is not clear that the analyzer is software. Since it is not identified in the specification or in any drawings as software, a person could easily look at the computer screens displaying the stored information and the associated weighting values and determine a resultant value, thus becoming an analyzer.

The appellant then states that specification is sufficiently enabling when considered by one skilled in the art. Appellant further states that the rejection as it related to claim 5 and a *purported subjective interpretation* is confusing the inputs to the tool used to perform the analysis with the [actual] analysis.

The appellant states that the analysis operates on these subjective values provided by the users. The appellant further states that, contrary to the rejection, the analysis will always produce the same result when the same values are provided.

Appellant further asserts that the analysis might produce different results where different values are provided, but appellant asserts that this is the purpose of the analysis, to operate on the values provided. Appellant then states that most equations will produce different results when different values are provided. Appellant states that, contrary to the statements of the rejection, the users conduct no experimentation, they simply answer the provided questions in the illustrated embodiments and the recommendation element then provides the resulting recommendation. (The Examiner notes that the term "recommendation element" is not identified in the specification or drawings but only used in the claim limitations).

Thus, the Examiner asserts that the claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to make or use the invention without undue experimentation since the subjective nature renders the invention incapable of providing a concrete, i.e., predictable and repeatable, result as required by statute. To be statutory, an invention must provide a repeatable and predictable result. The Examiner asserts that because the appellant has failed to provide sufficient guidance and direction to provide the necessary repeatable and predictable results, one skilled in the art would have to perform undue experimentation to make or use the invention. The Examiner asserts that unspecified values assigned in an unspecified way render it virtually impossible for one of ordinary skill in the art to make and use appellant's invention without undue experimentation. As set forth by appellant in the Appeal Brief (page 12), the weighted analysis values are utilized to form a score with the score translated to a recommendation. Appellant states in the Appeal

Art Unit: 3629

Brief (page 13), that the actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experience lawyers in the field. These statement, in and of itself, is evidence of the inability to produce a repeatable and predictable result. Because the appellant has not provided sufficient guidance and direction and because the values are subjective, for a single situation, there could be different results based on this subjective analysis and determination of each user. The subjective values would result in different scores, and thus different recommendation, depending on the individual users. Even for the same fact situation, different users could come up with different scores and thus a different recommendation. Thus, for a given situation, for each individual performing the invention, the score derived from the weighted analysis, and thus the recommendation, could be different. Therefore, the Examiner submits that the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to user the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant. As set forth above, appellant has not defined what scale is used, what the weighted analysis values are or how they are applied, or how the resulting score can be translated into a recommendation. As stated by appellant in the Appeal Brief (page 12), the actual numerical values would likely vary based on the specific techniques utilized. Appellant further states that once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then.

Art Unit: 3629

The Examiner asserts that it is unclear what appellant means by "[a]ny numerical values utilized in the analysis process are internal to the tool itself and are used in the internal calculations and analysis" and "[a]s such, these numerical values need not necessarily have a specific meaning to a person in the industry" (page 12 of the Appeal Brief).

Claim 5 claims a recommendation element using the determined resultant value and the associated decision option to provide a recommended decision. The Examiner requested that the appellant identify what defines a "recommendation element" since it is not identified in the specification. Furthermore, the Examiner asserts that there is not sufficient guidance and direction in appellant's specification to enable one skilled in the art to use the determined resultant value and the associated decision options to provide a recommended decision without undue experimentation.

In the instant Appeal Brief, the appellant states that:

As to the recommendation element, Applicants quote ¶ 36: "The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation." Thus the recommendation element takes the resultant values, the weighting values in ¶ 36, and combines them to form a score, which is translated to a recommendation, the recommended decision. The particular scores are correlated to a particular recommendation based on input from experienced lawyers. Applicants refer to ¶¶ 35-37 for an example on how a recommended decision is made. As explained for that embodiment, entry or data values are used in a weighted analysis. The weighting values are combined to form a score, which is translated to a recommendation. Other methods are then mentioned, including correlation and statistical decision tree analysis. Applicants thus submit it is very clear what the recommendation element is and how the recommended decision is made.

The Examiner asserts that appellant has provides generalities, i.e. combining undefined weighted values to form an undefined score. Appellant then states that this undefined score is translated into a recommendation. Appellant states that the undefined "recommendation element" takes the undefined resultant values, the undefined weighting values and combine them into a score, wherein the meaning to the score or the relevance of the score is also undefined. Appellant states that the scores are correlated to a particular recommendation based on input from experienced lawyers. It is unclear what qualifies one as an "experienced lawyer".

Claim 6 is directed to the tool of claim 5, further comprising a collection of results of the decision in prior litigation and the selected information for those litigations and wherein one of said analyzer and said recommendation element utilize said collected results to develop a resultant value or recommended decisions. As set forth above, the specification does not describe or provide guidance as to the elements of the step or how to perform this step, i.e., determining the resultant value or recommended decision, in such a way as to enable one skilled in the art to make or use the invention.

Claim 8 states that and accessor utilizes the decisions of each of the plurality of tools and the stored information to provide an assessment.

As to how the assessment is provided, appellant states that:

Applicants first refer to [paragraph] 30 and Fig. 4. Recommendation 310 is the assessment for the illustrated case. Quoting from [paragraph] 30: "This is based on the analysis of the collected data and case history review of similar cases and provides a recommendation as to the assessment and procedure for the particular case." Thus the assessment is the recommendation for the overall litigation, not just a recommendation on one decision or element of the litigation. Paragraph 31 describes an overview of the various steps and states: "Each of these are task and data gathering steps to help develop recommendations.

The actual data gathered is used in a weighted manner to help determine the recommendation." Proceeding then to [paragraph] 33, which relates to business/venue analysis, it states: "The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool." Next proceed to [paragraphs] 35 and 36, discussed above in more detail, which provide details on removal analysis and also the general analysis techniques and methods used in the illustrated embodiments of the invention. Paragraphs 38 (responsive pleading task), 41 (claim and evidence), 42 (particular termination), 43 (prior charges), 44 (comparator), 45 (decision to terminate) and 50 (damages) discuss further data used in the weighting analysis. See ¶ 49 which states: "Thus, this is a systematic way to gather all of the proof points necessary for the case, with the proof point data being used in the weighting analysis to help determine overall recommendation for the particular case." Applicants submit that the specification does describe a technique to provide an assessment or overall recommendation of the case and therefore the rejection is improper.

For the reasons set forth as to the discussion as to claim 5, the Examiner asserts that the subjective input utilized in the decisions of the plurality of tools and the selected information renders the invention incapable of providing a predictable and repeatable assessment as required by statute without undue experimentation. The specification does not describe how the assessment is performed or what goes into the assessment in such a way as to enable one skilled in the art to make or use the invention. Furthermore, the term "accessor" has not been defined in the specification or identified in the drawings. Thus, it is unclear whether the term encompasses a human or not.

Claims 9-12 identify a statistical decision tree. The Examiner asserts that the specification does not describe how to develop the decision tree in such a way as to enable one skilled in the art to make or use the invention without undue experimentation.

Art Unit: 3629

The specification discloses:

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit.

The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0036] It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer. Using screens not shown, experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against **a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers.** In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

In the arguments submitted with the Appeal Brief (page 17), appellant states:

Applicants traverse the rejection. The use of a statistical decision tree is specifically mentioned in ¶ 36. Applicants quote: "In the more complicated situations, such as the full case recommendation shown in Fig. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. **The statistical decision tree is developed from prior case results and/or input from experienced lawyers.**" Applicants submit that statistical decision trees and the

Art Unit: 3629

particulars of their development are well known to those skilled in the art and thus are not required to be explained in detail. A simple search on Google results in thousands of hits, one indicator that the technique is well known. Reversal of the rejection is requested.

The appellant has not clearly defined the decision tree in the specification. There is no guidance as to how to match the individual recommendations against a statistical decision tree or how the tree is used to provide a recommendation. Therefore, the Examiner asserts that the appellant has not provided sufficient guidance and direction as to how one skilled in the art would go about developing a statistical decision tree or what input goes into the development of the statistical decision tree, or how the tree is used to provide a recommendation. Thus, the Examiner asserts that one skilled in the art would not be able to make or use appellant's invention without undue experimentation.

B. Section 112, 1st paragraph Utility

This rejection has been *withdrawn*.

C. Section 112, 2nd paragraph (indefinite)

Note: The Examiner notes that appellant indicates that this is "B".

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

First, the Examiner asserts that it is not clear what statutory class the invention falls into. The appellant simply identifies the invention as a tool. However, there is no

Art Unit: 3629

clear structure identified and there are no clear method steps being performed. For example, claim 1 identifies the invention as comprising an entry field, a menu, storage of discovery related information, form discovery materials, and a discovery production mechanism. A menu and form materials are clearly are not proper structure for an apparatus, but are written data.

In the amendment submitted by the appellant on June 21, 2006, the appellant states in the Remarks/Argument section that:

The Office Action rejects claims 1-12 under § 112, ¶ 2 for several reasons. First, the Office Action states it is unclear which statutory class the invention falls into. ***Applicants submit the present claims are properly classified as apparatus or system claims.*** The present claims are a combination of graphical user interface elements and related data fields (See claim 1, entry field and view), physical storage (See claim 1, storage), stored information (form discovery materials), and a generally computer-implemented process (discovery production mechanism). Claims 5 and 8 have similar correlations. Each element clearly falls into the apparatus classification, so the whole invention must then also fall into the apparatus classification.

Second, the Office Action requests a definition for "a tool." Applicants are using normal meaning for the term. For example, ***tool*** as a noun is defined as ***"something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession"*** in Webster's Ninth New Collegiate Dictionary. When the specification and claims are reviewed, Applicants submit that their use of the word is consistent with that definition, an ordinary meaning of the word "tool."

Third, the Office Action requests clarification of the phrase "an entry field ..." in claim 1. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described embodiment and is not

Art Unit: 3629

to limit the meaning of the claim term to that specific example.

Fourth, the Office Action requested identification of an "analyzer." Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here.

Fifth and finally, the Office Action is confused by the use of "tool" for both claim 5, and claim 8 which incorporates claim 5. Applicants submit that the response related to the claim objections addressed this rejection.

In the instant appeal brief, appellant states that the present claims are properly classified as apparatus or system claims. Appellant states that the present claims are:

A combination of graphical user interface elements and related data fields (See claim 1, entry field and menu), physical storage (See claim 1, storage), stored information (form discovery materials), and a generally computer-implemented process (discovery production mechanism). Claims 5 and 8 have similar correlations. Each element clearly falls into the apparatus classification, so the whole invention must then also fall into the apparatus classification.

The Examiner notes that claim 1 is directed to a tool, comprising, an entry field available on a plurality of views, a menu for gathering information, storage of information, form materials and a production mechanism for combining information.

The appellant states in the instant Appeal Brief that:

The Office Action baldly states that a menu and form materials are clearly not proper structure for an apparatus but are written data. The Office Action errs in those points. A menu, particularly the claimed menu which is responsive to a request using an entry field, is clearly a user interface element, which is classically an apparatus element. Form materials are also not just written data but would be stored so that they can be combined by the discovery production mechanism, which is not disputed as being an apparatus. Thus those elements are sufficient so that it is clear that the claim is for an apparatus.

First, the Examiner asserts that MPEP 2111 requires the Examiner to give claim limitations the broadest reasonable interpretation in light of the specification without reading limitations from the specification into the claims.

The Examiner asserts that a menu, as claimed, is not clearly a user interface element. Moreover, a user interface element can be software which is not structure. A graphical user interface (GUI) is structure, but appellant has not claimed a GUI. Moreover, the Examiner asserts that a GUI would display a menu but the menu, in and of itself, is not structure.

Furthermore, the Examiner disagrees with the appellant's argument that "form materials are also not just written data but would be stored so that they can be combined by the discovery production mechanism, which is not disputed as being an apparatus". The Examiner asserts that the "form materials" are not structure of an apparatus or system. Moreover, while the Examiner contends that the discovery production mechanism can be an apparatus, since the appellant has not identified or defined what the structure is, broadly reading it in light of the claim limitations, it can be a stapler since a stapler is fully capable of combining stored discovery related information and form discovery materials to produce discovery items for use in litigation.

Claim 5 is directed to a tool for recommending a decision in litigation comprising interfaces, storage, weighting values, an analyzer, resultant values and a recommendation element. Weighting values appear to be a method step. Weighting values clearly are not structure of an apparatus or a system. Resultant values are not

Art Unit: 3629

structure. Therefore, it is unclear what statutory class the appellant's invention resides in.

The Examiner also requests the appellant to identify the term "analyzer" since it is not defined in the specification nor identified in the drawings.

In the instant Appeal Brief, appellant states:

Fourth, the Office Action requested identification of an "analyzer." Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here. Again, this response was previously provided and not addressed.

In the Remarks/Argument section submitted with the amendment on June 21, 2006, appellant stated:

Fourth, the Office Action requested identification of an "analyzer." Applicants respectfully submit that numerous examples have been described above, such as with reference to ¶ 36, and no further explanation is necessary here.

Thus, the Examiner asserts that the appellant has never responded to this question or defined or identified the term "analyzer". The Examiner asserts that as such, the term "analyzer" can encompass a human being.

Claim 8 is directed to a tool for assessing a litigation comprising a plurality of tools, interfaces, storage, and an assessor. The term "accessor" is not defined in the specification or identified in the drawings. The Examiner states in the Office Action mailed on September 7, 2006 that the appellant fails to identify what an assessor is in the specification. The Examiner notes that the appellant has yet to respond to this rejection by identifying or defining the term "accessor". The Examiner asserts that as such, the term "accessor" can encompass a human being.

Appellant states that the Office Action requests that appellant define the term "tool". In response, the appellant states:

As noted in the Office Action, Applicants are using normal meaning for the term. For example, tool as a noun is defined as "something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession" in Webster's Ninth New Collegiate Dictionary. When the specification and claims are reviewed, Applicants submit that their use of the word is consistent with that definition, an ordinary meaning of the word "tool." The Office Action provided no response to this argument, simply adding the note which appears to answer the question. Applicants submit that the rejection is improper.

Since the appellant states that a tool is an instrument or apparatus, the Examiner asserts that it is unclear how a menu, form discovery materials, weighting values resultant values, etc. provide structure to the apparatus.

NOTE: The appellant defined "a tool" in the arguments submitted on June 21, 2006 as something (as an instrument or apparatus) used in performing an operation or necessary in practice of a vocation or profession).

The Examiner requested that the appellant clarify what appellant means by the following language in claim 1 – *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

In the instant Appeal Brief, appellant states that:

Again Applicants responded in the June 21, 2006 response and the Office Action failed to address the response. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described

Art Unit: 3629

embodiment and is not to limit the meaning of the claim term to that specific example.

The Examiner asserts that this still does not clarify what is meant by the field being available on a plurality of views not directly related to discovery to request collection of discovery request.

The Examiner asserts that claim 8 identifies the invention as "a tool". However, the body of the claim language states that there are a plurality of tools according to claim 5 and requested the appellant to clarify this.

In the instant Appeal Brief, appellant states that:

Fifth and finally as to the indefiniteness rejections, the Office Action is confused by the use of "tool" for both claim 5 and claim 8 which incorporates claim 5. ***Applicants repeat these remarks from the prior response***, which also was not addressed by the Office Action. Claim 5 defines a singular tool according to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to assess a litigation. Thus claim 8 utilizes the various decisions ***provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation***. As an analogy, if claim 5 were to claim a wrench, then claim 8 would include a plurality of the wrenches of claim 5. The claim format, while unusual, is proper and Applicants submit that the rejection should be reversed.

First, the Examiner notes that appellant has never really addressed this in a prior response. In the Remarks/Arguments section submitted on June 21, 2006, the appellant simply states:

Fifth and finally, the Office Action is confused by the use of "tool" for both claim 5, and claim 8 which incorporates claim 5. Applicants submit that the response related to the claim objections addressed this rejection.

Claim Objections

Claims 8-12 were objected to as being of improper dependent form. Applicants respectfully traverse the objection. Claim 8 is an independent claim, not a dependent claim, and is of proper form. Claim 5 defines a singular tool according

to the present invention, a tool to recommend a particular decision in a litigation. Claim 8 uses a plurality of the singular tools of claim 5 to assess a litigation. Thus claim 8 utilizes the various decisions provided by the plurality of tools of claim 5 used as elements in claim 8 to provide an assessment of the litigation. As an analogy, if claim 5 were to claim a wrench, then claim 8 would include a plurality of the wrenches of claim 5. The claim format, while unusual, is proper and Applicants submit that the objection should be withdrawn.

Again, the Examiner asserts that appellant has failed to clarify the claim

limitations. Appellant states that claim 8 utilizes the various decision provided by the plurality of tools of claim 5 to provide an assessment. However, claim 5 is only directed to one tool. Moreover, if this is the same litigation, why would you use a plurality of the tools as set forth in claim 5? Where do the various decisions come from in claim 5?

D. Section 101 Rejections

Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

The Examiner asserts that it is not clear what statutory class the appellant's invention would fall into. The appellant identifies the invention as a tool. Appellant further identifies the term tool (see page 19 of the Appeal Brief) as "something (as an

Art Unit: 3629

instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession". However, the Examiner asserts that there does not appear to be sufficient structure identified for an apparatus. For example, in claim 1, the appellant states that the tool comprises an entry field, a menu, form discovery materials and a discovery production mechanism. Thus, the invention is not clearly a machine/apparatus or system. The appellant does not clearly define method steps although such language as set forth in claim 1 could be construed to be a method step (storage of discovery related information gathered from said menu).

Claim 5 is directed to a tool comprising interfaces, storage, weighting values, an analyzer, resultant values and a recommendation element. The Examiner asserts that interfaces can be software and that weighting values and resultant values clearly are not structure. Appellant has not defined the term "analyzer" in the specification nor identified it in the drawings. The broadest reasonable interpretation of the term "analyzer" could encompass a human being. Since appellant states that the tool is an apparatus, a human analyzer could also render the claim non-statutory.

Claim 8 is directed to a tool comprising a plurality of tools according to claim 5, interfaces, storage, and an accessor. As set forth above, interfaces can be software. Again, appellant has not defined the term "accessor" in the specification or identified it in the drawings. Thus, the broadest reasonable interpretation of the term "accessor" can encompass a human being.

Therefore, the invention does not clearly fall into the statutory class of process or method. It is not an article of manufacture or a composition of matter. Therefore, the invention appears to be non-statutory.

NOTE: In appellant's remarks submitted with the amendment filed on June 21, 2006, appellant states that the claims are properly classified as apparatus or system claims. The appellant states that the present claims are a combination of graphical user interface elements and related data fields, physical storage, stored information, and a generally computer implemented process (page 9). Stored information is not structure. Data fields are not structure. Moreover, the appellant has not claimed a graphical user interface element.

Furthermore, it is not clear whether the tool is software or a web site or web pages. Although appellant states that a "tool" is defined as "something (as an instrument or apparatus) used in performing an operation or necessary in the practice of a vocation or profession", software can also be something used in performing an operation or necessary in the practice of a vocation or profession. Moreover, appellant's specification states that Figure 2 illustrates an exemplary computer system for operating a tool according to the present invention (see paragraphs [0017] and [0027]).

Even though appellant states that the invention is directed to an apparatus, the claims could be construed to be drawn to a web site or web pages. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware. The fact that appellant is claiming an entry field, a menu, form discovery materials, interfaces for

Art Unit: 3629

gathering information does not preclude the appellant's invention from being directed to a web site or web pages.

According to common definitions and barring any "special definition" in an application, web sites or web pages are *files or documents*, not the computer or network hardware that makes available or presents these files. The MPEP gives us guidance on how to deal with files or documents at MPEP 2106 IV B 1 (a) and (b), under the headings of "functional descriptive material" and "nonfunctional descriptive material".

If the files or documents are data structures or computer executable code, they are statutory if they are embodied on a computer-readable medium, provided of course they provide a useful, concrete and tangible result. If the files or documents are nonfunctional descriptive material, e.g. music, photographs, compilations of data, such material cannot exhibit any functional interrelationship with the way in which computing processes are performed and would not be statutory. This is true even if the nonfunctional descriptive material is embodied on a computer-readable medium.

Claims 5-12 are further rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.

An analysis of the appellant's claimed invention as to whether it is statutory or not under 35 USC Section 101 because of this subjective analysis and because of the lack of guidance and direction as to what and how to apply the numerical values is set forth below.

35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter.

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 USC Section 101, the Examiner must first identify whether the claims fall within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter). As set forth above, it is unclear to the Examiner what statutory class appellant's invention falls into. However, in the instant Appeal Brief, appellant states that:

The first § 101 rejection was based on non-statutory subject matter. Applicants submit this rejection has been addressed above with the § 112, ¶ 2 rejection, where it was clearly illustrated ***the present claims are properly apparatus claims***. The Office Action makes various remarks about data fields not being structure and files or documents being functional or non-functional descriptive material. The common error in these remarks, in particular, and in the § 112, 2nd paragraph and § 101 rejections on this point in general, is that the citations and rejections are based on rules and policies relating to the claim as a whole, not to individual elements. It is clear that it is the claim as a whole that must be reviewed. One cannot simply find one element and declare the claim non-statutory on that basis, which appears to be the approach taken in the Office Action.⁵ This further is the case when the allegedly non-statutory elements are utilized in or products of other clearly statutory elements.

Therefore, as an apparatus, the appellant's invention falls into one of the enumerated classes.

Upon making the determination that the invention is an apparatus that falls within enumerated statutory classes, the Examiner must now determine whether the claimed invention falls within one of the Section 101 judicial exceptions, i.e., is the invention directed to laws of nature, natural phenomena or an abstract idea.

Inventions directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible and therefore are excluded from patent protection. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." *Le Roy*, 55 U.S. (14 How.) at 175. Instead, such "manifestations of laws of nature" are "part of the storehouse of knowledge," "free to all men and reserved exclusively to none." *Funk*, 333 U.S. at 130, 76 USPQ at 281.

The Examiner asserts that the appellant's invention appears to provide a score which is translated into a recommendation. The Examiner asserts that this score is an aggregation of the user's subjective judgment. Thus, the Examiner asserts the appellant's invention is nothing more than a mathematical formula used to provide a score which is translated into a recommendation, thus is a mathematical expression,

and, therefore, is an abstract idea. As stated above, one cannot patent “a novel and useful mathematical formula.”

However, the evaluation under 35 USC Section 101 does not stop here. While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself.

The Examiner must ascertain the scope of the claim to determine whether it covers either a § 101 judicial exception or a practical application of a § 101 judicial exception. The conclusion that a particular claim includes a § 101 judicial exception does not end the inquiry because “[i]t is now commonplace that an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original); accord *Flook*, 437 U.S. at 590, 198 USPQ at 197; *Benson*, 409 U.S. at 67, 175 USPQ at 675. Thus, “[w]hile a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.” *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9 (quoting *Mackay*, 306 U.S. at 94); see also *Corning v. Burden*, 56 U.S. (15 How.) 252, 268, 14 L.Ed. 683 (1854)(“It is

Art Unit: 3629

for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”).

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 (“application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it “has no substantial practical application”).

To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

(a). The claimed invention “transforms” an article or physical object to a different state or thing.

(b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The Examiner asserts that the appellant’s invention does not transform an article or physical object to a different state or thing. Calculating a metric (score) using a formula on a computer does not transform an article or physical object to a different state or thing.

For eligibility analysis, physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. Since the Examiner determined that the claims do not entail the transformation of an article, the

Examiner must review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is “useful, tangible and concrete.” The claim must be examined to see if it includes anything more than a § 101 judicial exception. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the examiner does not find such a practical application, the examiner has determined that the claim is nonstatutory. In determining whether a claim provides a practical application that produces a useful, tangible, and concrete result, the examiner considers and weighs the following factors:

- 1). Whether the invention produces a “concrete” result?

Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In *re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art.

The Examiner asserts that the appellant’s invention does not produce a repeatable or predictable result.

Claim 5 is directed to a tool comprising interfaces, storage, weighted values, an analyzer, resultant values and a recommendation element. Claim 5 is directed to associating weighting values with each element and an analyzer using the stored information and the associated weighted values to determine a resultant value, said resultant values associated with various decision options, and a recommendation element using the determined resultant value and the associated decision options to provide a recommended decision.

Claim 8 is directed to a tool comprising a plurality of tools, interfaces, storage and an accessor. Claim 8 discloses an accessor utilizing the decisions of each of the plurality of tools for providing an assessment relating to litigation.

At the onset, the Examiner notes that neither the term “analyzer” nor the term “accessor” are identified in the body of the specification or any of the drawings. The only place that these terms are found are in the claim limitations. Thus, the Examiner asserts that the broadest reasonable interpretation of these terms can encompass a human being.

The Examiner further asserts that the specification fails to provide sufficient guidance and direction to enable one skilled in the art to make or use the invention without undue experimentation.

For example, the appellant’s specification discloses:

(ABSTRACT) A tool which provides counsel with a data collection mechanism to guide them through various steps in the litigation process and directs counsel and/or legal assistants to determine what information is required. The tool provides a "Discovery Generator" that is available to capture counsel's potential discovery requests, which are linked to existing document and form production tools for facilitated production of discovery. The tool informs the user of

the percentage of progress of the required information that has been entered. The tool provides ***an analytical framework that captures the judgment of seasoned practitioners to provide a comprehensive analysis of the legal, factual, and business aspects of the lawsuit. The tool provides methodologies that quantify subjective analyses through the use of weighted measuring schemes.*** The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to queries to aid in the capture and analysis of information. To do this the tool directs counsel to assign values to reflect the importance of various aspects of the litigation. Based on the values that are assigned, counsel's assessment of the particular aspect of the litigation which is captured through the queries mentioned above, and statistical assessments of likely outcomes based on historical records of previously captured information and analogous assessments, the tool provides counsel with suggested paths forward. This process occurs on both a step by step basis as well as with an overall assessment of the case.

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. The tool provides a decision tree structure underlying the various steps of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0014] Additionally, the tool directs counsel to assign values to reflect the importance of various aspects of the litigation. Based on (1) ***the values that are assigned, (2) counsel's assessment of the particular aspect of the litigation which is captured through the yes/no queries mentioned above, and (3) statistical assessments of likely outcomes*** based on historical records of previously captured information and analogous assessments, the tool provides counsel with suggested paths forward.

[0015] This process will occur on both a step by step basis as well as with an overall assessment of the case. ***Through this multi-step process, counsel, in cooperation with the client, analyze the strengths and weaknesses of the case and determines the appropriate path forward.*** This process is conducted in cooperation with other counsel involved in the case in order to reduce costs and to promote efficiency.

The Examiner asserts that the instant specification discloses assigning values to reflect the importance of various aspects of the litigation and a statistical assessment of likely outcomes base on historical records [0014]. However, the actual values

used or how the values are assigned or weighted has not been sufficiently disclosed so that one of skill in the art would know what the values are or how to assign them. Appellant has not disclosed what the values are or what the values represent. How does one skilled in the art go about weighting or assigning these values? How does an analyzer determine a resultant value using the stored selected information and the associated weighting values? The instant specification does not disclose an equation used to determine the resultant values. There is no guidance or direction as to how these resultant values are associated with various decision options. Without knowing what the values are or how to weight or assign the values, or how the resultant value is determined, one skilled in the art would simply be left to guess what the values are, how to assign them, and how to determine a resultant value which is used to provide a recommended decision.

Appellant's specification further discloses:

[0031] It is, of course, necessary to enter data and that is done by going to a task screen 312 shown in FIG. 5. In the left hand column of the illustrated screen 312 it is noted that there are a series of tasks which need to be performed, including review of the complaint; doing a venue and business analysis, issuing a FOIA request; requesting other agency documentation; doing a locus determination; a court admission evaluation; analysis of the local rules; any legal research necessary; an early evaluation of the discovery; a jury venire; removal analysis, which will be discussed in more detail below; responsive pleading requirements, which is also discussed in more detail below; transfer analysis and early case assessment. Each of these are task and data gathering steps to help develop recommendations. ***The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field.***

[0033] FIGS. 6-10 are screen shots illustrating the venue/business analysis

questions. As can be seen, there are a series of questions relevant to determining venue for the particular case and doing a business analysis to see the business factors of the case. **As to each particular question, an assessment value is provided as shown in FIG. 10.** For example, particular assessments are such as strongly favors defendant, favors defendant, no effect, favors plaintiff and strongly favors plaintiff. **These assessments are then weighting values that are entered for each particular question.** The result of the assessment and weight value factoring is used to help calculate recommendations provided by the tool. A recommendation could be presented, but is not shown in the exemplary embodiment. Generally, this particular set of questions would be entered by a lawyer, rather than a legal assistant, as generally some experience is required for these particular questions.

[0035] FIGS. 19 through 22 illustrate the exemplary screens used for the removal analysis. For example, there are questions as to whether it was a state or federal court filing, and if it was a state court filing, if there was a basis for removal, what type of jurisdiction and so on. Further, there are a series of decision points that must also be made and these are selected from a list as shown in FIG. 22, which can include strongly favors removal, favors removal, no effect in removal, favors remaining in state and strongly favors remaining in state. **Again, these particular selections of the decision values are used in a weighting analysis to determine whether to provide the removal recommendation.** It is further noted that under each particular category of decision is an analysis block so that the user can indicate the particular thought process used to develop the particular indicated decision. This allows review by more experienced parties, associates or more skilled partners for example, without requiring the actual in person presence of the particular user that entered the data.

[0036] **It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer.** Using screens not shown, **experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation.** Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. The

statistical decision tree is developed with prior case results and/or input from experienced lawyers. In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

[0037] ***Based on the results of the weighted analysis and review or comparison to similarly situated cases, a recommendation is provided by the tool.*** In the illustration of FIG. 21, the recommendation is to Remove. Although not shown in FIG. 21, it would also be appropriate to include the percentage values of data collection and reliability to go with the particular recommendation value to allow a quicker evaluation of the recommendation value.

[0038] FIGS. 23-28 are exemplary screen shots of the responsive pleading task. In this instance, the decision to be made is to answer, dismiss or move for a more definite statement. Within the right-hand side of each of the screen shots are percent complete, reliability and recommendation values. Also shown in FIG. 23 are the determinations necessary to develop the recommendation. A series of questions are provided with entry locations to determine the amount of time and/or dollars necessary to perform the indicated task. These time and/or dollar values are then used to develop an approximate cost for an answer. It is noted that an answer is always accepted by the court and therefore there is no need to do an analysis on the probability of success. FIG. 26, on the other hand, shows a motion to dismiss exemplary screen shot. It is noted on the bottom of the screen there are entry values for the particular times and/of costs for the particular tasks to develop a cost for this alternative. Above that are a series of questions that have drop down or selection boxes to allow the user to select particular answers for each question. ***Appropriate values for each particular question are incorporated into the drop down list and are assigned particular numerical values. The numerical values for each of the particular answers is then used in a weighted analysis to determine probability of success,*** which is then coupled with the cost to develop a probabilistic value, which is then compared with the cost of an answer and the cost of a motion for more definite statement. The questions and task entries for a more definite statement are shown on FIG. 27. When entries have been made for all of the particular values, a complete recommendation can be made. In addition, as data is entered, the percentage completed and reliability numbers are updated so that not necessarily all data

needs to be provided to reach a certain level of confidence in the particular recommendation. In the illustrated example the recommendation is to Answer rather than to move to dismiss or for more definite statement. The weighting and probability values are entered as previously described. For the particular responsive pleading analysis, the data values could be entered by a combination of attorneys and legal assistants.

The Examiner asserts that the appellant has identified an invention which requires a user to input information into a computer wherein many of the values entail the subjective judgment of the user. As set forth in appellant's specification the invention is directed to a tool that provides an analytical framework that captures the judgment of seasoned practitioners to provide a comprehensive analysis of the legal, factual, and business aspects of a lawsuit (abstract). The tool directs the attorney to assign values to reflect the importance of various aspects of the litigation. Based on the values that are assigned and the attorney's assessment of particular aspects of the litigation and statistical assessments of likely outcomes based on historical records previously captured and analogous assessments, the tool provides the attorney with suggested paths. Through this process, counsel, in cooperation with the client, analyze the strengths and weaknesses of a case and determine the appropriate path forward [0014-0015]. The actual data gathered is used in a weighted manner to help determine the recommendation. The actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field [0031]. Appellant discloses that each of the data values includes a particular value which is used in a weighted analysis as derived by an experienced lawyer. Experienced lawyers provide weighting factors for each particular data value. These weighting values are

then combined to form a score which is then translated into a recommendation [0036].

The Examiner notes that appellant's invention takes the subjective input of a user and enters it into the computer to produce a recommendation. The Examiner asserts that because the values are subjective, how they values are weighted and how they are assigned are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. As set forth above, appellant's invention is a tool that provides a framework that ***captures the judgment of seasoned practitioners***. The actual weighting values are ***based on assessments of criticality for each particular response as determined by skilled and experience lawyers***. This actual data gathered is used in a weighted manner to determine a recommendation.

The Examiner asserts that the appellant does not provide sufficient guidance or direction as to an actual numerical value being used or how the value is assigned or weighted. As set forth above, the invention aggregates a user's judgment and condenses the judgment into a recommendation. It is unclear from the disclosure how a computer would be programmed to provide a value and assign or weight the value in order to take into account all of the subjective answers which the process entails and produce a predictable and repeatable result. Although the instant

specification is replete with generalizations regarding the values, it is short on any specific direction or guidance as to what the values actually are or how they or assigned or weighted. It is the subjective nature of appellant's input into the computer and the lack of guidance and direction as to the meaning and application of values that raises the question of predictability and repeatability. The Examiner asserts it is this subjective analysis and judgments in applying undefined values that prevents the invention from producing a repeatable and predictable result without undue experimentation.

The appellant states in the instant Appeal Brief that the illustrated embodiments utilize weighted analysis values to form a score, with the score transmitted to a recommendation. The appellant further states that the end result of the tool is a recommendation and that any numerical values utilized in the analysis process are internal to the tool itself and used in the internal calculations and analysis. Appellant contends that as such, those numerical values need not necessarily have a specific meaning to a person in the industry. Appellant asserts that it is sufficient that they [the values] have a range and that the range is known so that scores can be converted to recommendations. Appellant states that the actual numerical values would likely vary based on the specific analysis techniques utilized in any event, so again absolute meaning of the specific numeric values is not necessary. Appellant asserts that once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then and is not required to be

Art Unit: 3629

defined with respect to the outside environments in any event. (The Examiner asserts that this statement raises a question as to specific and substantial utility of the invention, but since the Examiner did not raise this issue, the Examiner only makes note of this issue).

Appellant then gives the following example (pages 12-13 of the Appeal Brief):

As an example, consider a series of different surveys. In some cases a ranking of 1 to 5 will be requested. In some of these instances 1 will be high while in others 5 will be high. Other surveys may be 1 to 3 or 1 to 10 or A to E. **The actual numerical values are irrelevant.** What is relevant is the relationship defined for the particular survey, which then operates on its own defined values. This survey example indicates the values only have defined meanings within the context of the survey itself, not some universally known value as apparently required by the rejection.

Appellant argues that the rejection next questions the weighting values.

Appellant states that:

Applicants quote from ¶ 31: "the actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experienced lawyers in the field." This is further described in ¶ 36, though the term weighting factors is used. Applicants submit this is extremely clear.

The Examiner asserts that while this statement is extremely clear, the claimed invention is not capable of producing a concrete result, i.e., a predictable and reproducible result without undue experimentation due to the lack of guidance and direction provided by appellant as to what these weighted values are or how they are applied. The fact that the actual **weighting values are based on assessments of criticality** for each particular response **as determined by skilled and experienced lawyers** in the field is further evidence that the invention is not enabled due to quantity of experimentation needed to make and use the appellant's invention so

Art Unit: 3629

that it provides a predictable and repeatable result as required by statute. The Examiner asserts that assessments by skilled and experienced lawyers are not repeatable nor predictable.

Appellant states that the Examiner next questions how the analyzer determines a resultant value. In response, appellant states:

Applicants quote from ¶ 36: "the weighting values are then combined to form a score, which is then translated into a recommendation."

In response to the Examiner's question as to how they [the weighted values] are combined, the appellant states:

Again that is relevant only to the internal operation of the tool, as the score is then translated into a recommendation. This is clear in the next sentence in ¶ 36: "Again, ***experienced lawyers would select the scores for a particular recommendation.***"

In response to the Examiner's question of what is an analyzer, is it a person or software, the appellant states that:

As the claimed invention is a tool, it is extremely clear that the analyzer is software. See ¶ 29: "Fig. 2 illustrates an exemplary computer system for operating a tool according to the present invention" and "In the preferred embodiment the actual tool runs as a series of Java applications loaded from the server 200 by certain runtime pieces that are installed locally on the workstation 206."

The Examiner asserts that as set forth in appellant's specification, it is not clear that the analyzer is software. Since it is not identified in the specification or any drawings as software, a person could easily look at the computer screens displaying the stored information and the associated weighting values and determine a resultant value, thus becoming an analyzer.

The appellant states that the analysis operates on these subjective values provided by the users. The appellant further states that, contrary to the rejection, the analysis will always produce the same result when the same values are provided. Appellant further asserts that the analysis might produce different results where different values are provided, but appellant asserts that this is the purpose of the analysis, to operate on the values provided. Appellant then states that most equations will produce different results when different values are provided. Appellant states that, contrary to the statements of the rejection, the users conduct no experimentation, they simply answer the provided questions in the illustrated embodiments and the recommendation element then provides the resulting recommendation. (The Examiner notes that the term "recommendation element" is not identified in the specification or drawings but only used in the claim limitations).

As set forth by appellant in the Appeal Brief (page 12), the weighted analysis values are utilized to form a score with the score translated to a recommendation. Appellant states in the Appeal Brief (page 13), that the actual weighting values are based on assessments of criticality for each particular response as determined by skilled and experience lawyers in the field. These statement, in and of itself, is evidence of the inability to produce a repeatable and predictable result. Because the appellant has not provided sufficient guidance and direction and because the values are subjective, for a single situation, there could be different results based on this subjective analysis and determination of each user. The subjective values would result in different scores, and thus different recommendation, depending on the individual users. Even for

Art Unit: 3629

the same fact situation, different users could come up with different scores and thus a different recommendation. Thus, for a given situation, for each individual performing the invention, the score derived from the weighted analysis, and thus the recommendation, could be different. Appellant has not defined how what scale is used, what the weighted analysis values are or how they are applied, or how the resulting score can be translated into a recommendation. As stated by appellant in the Appeal Brief (page 12), the actual numerical values would likely vary based on the specific techniques utilized. Appellant further states that once the particular entry value correlations, weighting analysis techniques and so on are defined for a particular embodiment, then a particular numerical value develops meaning, but not until then.

Claims 9-12 identify a statistical decision tree. The Examiner asserts that the specification does not describe how to develop the decision tree in such a way as to enable one skilled in the art to make or use the invention without undue experimentation so as to produce a predictable and repeatable result.

The specification discloses:

[0013] These measuring schemes are incorporated into steps that are designed to assist counsel to make a factual assessment, a legal assessment, a staffing assessment, a business assessment, and a budget assessment of the lawsuit. ***The tool provides a decision tree structure underlying the various steps*** of the methodology activated by user's answers to yes/no queries to further aid in both the capture and analysis of information.

[0036] It is noted on FIG. 21 that a recommendation value is provided. It is understood that the particular data is entered as described above. Each of the data values includes a particular value which is then used in a weighted analysis as derived by an experienced lawyer. Using screens not shown,

experienced lawyers provide weighting factors for each particular data value. The weighting values are then combined to form a score, which is then translated into a recommendation. Again, experienced lawyers would select the scores for each particular recommendation. In some embodiments of the tool the data values are compared with prior cases and a correlation is done. This correlation then provides a recommendation, which can be combined with the score-based recommendation or provided separately. In more complicated situations, such as the full case recommendation shown in FIG. 4, the individual recommendations and other data points are matched against **a statistical decision tree, providing a recommendation for those cases. The statistical decision tree is developed with prior case results and/or input from experienced lawyers.** In other alternatives for both the simpler and more complex situations, various machine learning techniques can be used, with complementary techniques used to provide the recommendations. Examples include supervised feedback learning via an N-dimensional hyperplane classifier, a variation on the ID3 algorithm of Quinlan, self organizing mapping techniques according to Teuvo Kohonen and other neural network techniques. The particular data collected from the user may vary by the particular techniques used to ensure convergence, but all data would be similar to that illustrated herein.

In the arguments submitted with the Appeal Brief (page 17), appellant states:

Applicants traverse the rejection. The use of a statistical decision tree is specifically mentioned in ¶ 36. Applicants quote: "In the more complicated situations, such as the full case recommendation shown in Fig. 4, the individual recommendations and other data points are matched against a statistical decision tree, providing a recommendation for those cases. **The statistical decision tree is developed from prior case results and/or input from experienced lawyers.**" Applicants submit that statistical decision trees and the particulars of their development are well known to those skilled in the art and thus are not required to be explained in detail. A simple search on Google results in thousands of hits, one indicator that the technique is well known. Reversal of the rejection is requested.

The appellant has not clearly defined the decision tree in the specification. There is no guidance as how to match the individual recommendations against a statistical decision tree or how the tree is used to provide a recommendation.

The Examiner notes appellant's argument wherein appellant states:

Art Unit: 3629

The second § 101 rejection is based on a requirement that the invention produce a useful, concrete and tangible result and a confusion about the use of subjective values in the invention.

While Applicants believe this has been addressed under the § 112, ¶ 1 Enablement and Utility rejections, Applicants again note that the Office Action is confusing input data with the operation of the invention. For a given set of input data, the invention will always produce the same result, a useful, concrete and tangible result, for claim 5 a recommendation and for claim 8 an assessment. Different inputs may well produce different results, but such is generally true.

Applicants submit that the § 101 rejections are improper and should be reversed.

The Examiner respectfully disagrees with the appellant's assertion and contends that the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to provide repeatable and predictable results – to the point that the users become the inventor of their own application of the invention rather than the applicant.

E. Section 102 Rejection

Claim 1

Appellant states that Newell is not related at all to developing discovery materials but instead Newell is simply a litigation management system, a hyperlinked database of all of the information and materials in the litigation.

The Examiner asserts that while Newell is a system and method for managing litigation information, Newell also discloses discovery information where each discovery entry includes a description of discovery document [0013]. The plurality of categories

and subcategories in Newell include discovery information [0030-0031]. Also, see Figures 3J-1 thru 3J-2 (Discovery web pages) and the discussion in paragraphs [0141-0144]; Figure 2 (202J) Discovery.

Appellant states that Newell only contains previously developed material. Appellant states that Newell does not contain "an entry field available on a plurality of views not directly related to discovery to request collection of discovery requests" nor "a discovery production mechanism to combine stored discovery related information and form discovery materials to produce discovery items for use in the litigation."

Appellant states that appellant specifically notes that the two specific examples mentioned, the entry field and the discovery production mechanism, which distinguish appellant's invention from Newell, are not elements which were the basis of the § 112 or § 101 rejections. Therefore, appellant states that there was no valid basis for simply ignoring most of the language of the claim elements.

The Examiner respectfully disagrees with the appellant's assertion. As to both the "entry field" and the discovery production mechanism, the Examiner has made numerous attempts to get the appellant to clarify the limitations.

Appellant is directed to the discussion under the rejection under 35 U.S.C. 112, 2nd paragraph wherein the following is stated:

The Examiner requested that the appellant clarify what appellant means by the following language in claim 1 – *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

In the instant Appeal Brief, appellant states that:

Again Applicants responded in the June 21, 2006 response and the Office Action failed to address the response. As a specific embodiment, and not a limitation to the claim language, Applicants refer to ¶¶ 53 and 54 and to Figs. 4, 99 and 100. As seen on Fig. 4, there is a button labeled "Discovery Generator." Clicking this button results in the drop down box shown in Fig. 100 appearing on screen. The drop down box is for entering specific discovery questions. As the "Discovery Generator" button is present on screens not directly related to discovery, as in Fig. 4, this Discovery Questions entry area is available on these other views. Applicants again note that this is a specific explanation of a specific described embodiment and is not to limit the meaning of the claim term to that specific example.

The Examiner asserts that this still does not clarify what is meant by the field being available on a plurality of views not directly related to discovery to request collection of discovery request.

The Examiner asserts that claim limitations are to define what the invention is, not what it is not. Thus, the Examiner asserts that the appellant has failed to positively claim appellant's invention.

As for the appellant's assertions as to the "discovery production mechanism" the Examiner notes the rejection under 35 U.S.C. 112, 1st paragraph. Although this rejection has been **withdrawn**, the Examiner and the appellant have had the following dialog as evidenced by the rejection mailed to appellant on September 7, 2006:

For example, in claim 1, the appellant claims a discovery mechanism to combine discovery related information and form discovery materials to produce discovery items for use in litigation. The specification fails to provide an adequate written description of the invention so that one of skill in the art could practice the claimed invention without undue experimentation. The specification does not

Art Unit: 3629

describe how to combine stored discovery related information and form discovery materials to produce discovery items, what mechanisms are used to make such combination, or how the data or what data is merged in such a way as to enable one skilled in the art to make or use the invention.

The specification states as follows:

[0009] The tool provides counsel with a data collection mechanism. This mechanism guides counsel through various steps in the litigation process and directs counsel and/or legal assistants to determine what information is required to reach the stated goals. For example, the tool provides a "Discovery Generator" that is available to capture counsel's potential discovery requests, which are normally thought of during the process of reviewing documents and then forgotten or lost. ***These potential discovery requests are captured and stored. Later, when discovery requests are called for, the tool provides links to existing document and form production tools for facilitated production of discovery***, such as Interrogatories or Requests for Production. Links to these document and form production tools are available at various steps in the use of the tool.

[0053] One of the important phases of a lawsuit is the discovery process. It is often long and complicated and used to gather much of the evidence and facts present for the particular case. It is common to have sample or form discovery materials available, particularly when the law firm is relatively experienced in a given area. However, in each particular case there are particular individualized discovery questions or relevant information which must be gained. Further, it is often common that these particular individualized questions are only developed as the evidence is being reviewed by the attorney and/or paralegal. To remember this particular question which has been developed during this document review, the person jots it down on a piece of paper or a note which is stuck on their monitor. Then during the course of the lawsuit the notes are lost or they fall off the monitor and are swept away. Thus this highly transitory and relevant information is lost and discovery is somewhat hampered. Review of FIGS. 99 and 100 illustrates that the tool includes a method of gathering and maintaining these particular transitory discovery questions. It is noted in the upper right-hand corner of the exemplary screen shots that there is a button indicated "Discovery Generator." Clicking on Discovery Generator brings up a drop down box shown in FIG. 100. The class or category of discovery is indicated, an entry is made to whom the particular discovery is directed and then the ultimate question is entered.

This question is then saved into a collection as shown on FIG. 99.

[0054] Also shown on FIG. 99 are a series of buttons and drop downs to generate the particular discovery materials. For example, buttons are shown for interrogatories, requests for production, requests for admissions, client requests and attorney notes. For deposition questions, witness questions, and agency requests, because these would all be directed to particular parties, selection boxes are provided to determine which are the desired parties for the desired discovery. When the selection is made or the button is clicked, the particular materials are generated. ***The tool selects the particular discovery questions shown in FIG. 99 and merges them with other form discovery materials relating to the particular type. When this is done, each related output is developed,*** generally with suitable word processing tools. Secretaries and assistants could fine-tune the particular documents as necessary for review by the attorney, who would provide additional fine-tuning. Thus the tool allows for positive, secure collection of the transitory discovery questions developed during document review and automates the inclusion of these relevant questions into standard materials commonly used.

Appellant's discloses in the specification, paragraph [0054], that the tool selects the particular discovery question and merges them with other form discovery materials. The appellant does not disclose how the tool selects the particular question or how the data is actually merged with other form discover materials. It is not clear what the actually gets incorporated into the materials or what the final product is.

The Examiner has ***withdrawn*** the rejection and will instead take the broadest reasonable interpretation of the term "discovery production mechanism to combine information and materials". The Examiner asserts that a stapler is fully capable of being a "discovery production mechanism to combine information and materials".

Thus, in applying prior art to claim 1, if a tool is an apparatus as asserted by applicant, then the prior art need only read on the structure of the apparatus. The

Examiner asserts that an entry field does not describe structure of an apparatus. Furthermore, an entry field can be any template on a screen for entering data as is disclosed in Newell (Figure 1a, [0056]; see also Figures 4B-1-5A). Newell discloses a menu (Figure 3A), storage [0024-0029] [0109], forms (Figure 3B-2 Common case Forms; Figure 2 (202W Special Verdict Forms)) and a production mechanism for combining documents [0100-0101] [0141-0144]).

Appellant has admitted that the invention is directed to an apparatus. Thus, the fact that the tool is for developing litigation discovery material is the intended use of the tool and given little patentable weight. Moreover, the fact that the menu is for gathering information is also intended use of the "apparatus" as claimed by appellant and also is given little patentable weight.

The Examiner further notes that limitations reading "discovery **related** information" or "information **related** to discovery" or "information **relevant** to the litigation can broadly be read to be about any kind of information.

Claim 5:

Appellants states that Newell is not related at all to recommending a decision in litigation, Newell being merely a hyperlinked database of case information. As such, appellant states that Newell does not disclose any of the claim elements starting at "weighting values associated with each element of selected information." Appellants also note that the Office Action has failed to even make a prima facie rejection. Appellant asserts that, in addition to ignoring most of the element language, as done

with claim 1, it [the Office Action] has failed to even cite an element in Newell which corresponds to the claimed recommendation element. Appellant asserts that the rejection is improper on its face and must be reversed.

Here again the Examiner will consider claim 5 to be directed to an apparatus. The fact that the tool is ***for recommending a decision in litigation*** is the intended use of the apparatus, and thus is given little patentable weight. Claim 5 is directed to a tool comprising interfaces (this could be software and as claimed, is not a positive recitation of structure), storage, and an analyzer (processor unit 112).

The fact that the interface is ***for gathering information*** is intended use of the interface and thus, in an apparatus claim, is given little patentable weight. The fact that the storage is ***for gathering information*** is also intended use. The Examiner asserts that weighing values/ resultant values are clearly not proper structure of an apparatus. Since it is not clear from appellant's disclosure what defines a recommendation element, the Examiner asserts that processor unit 112 could process the resultant values and associate decisions.

Claim 8:

Appellants again state that Newell is not related at all to assessing a litigation, Newell being just a hyperlinked database. As such, appellant's assert that Newell clearly does not disclose the "plurality of tools according to claim 5, each tool for a decision in the litigation" or "assessor utilizing the decisions of each of said plurality of tools and the stored further selected information for providing an assessment."

Art Unit: 3629

Appellants state that as above in the rejections of claims 1 and 5, most of the language in each element has been omitted. And, similar to claim 5, the Office Action has failed to even cite an element in Newell corresponding to the assessor element in claim 8.

Appellant asserts that again the rejection is improper on its face and must be reversed.

Once again the Examiner asserts that claim 8 is directed to an apparatus.

Therefore, the fact that the tool is ***for assessing a litigation*** is the intended use of the tool. Thus, claim 8 is directed to a tool, comprising a plurality of tools, interfaces, storage and an accessor. As set forth above in the rejection under 35 U.S.C. 112, 2nd paragraph, the appellant has failed to define the “accessor” in the specification and does not identify it in the drawings. As such, the broadest reasonable interpretation of an accessor can be a human being which would render the claim 8 non-statutory.

MPEP 2105 states that:

If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. Furthermore, the claimed invention must be examined with regard to all issues pertinent to patentability, and any applicable rejections under 35 U.S.C. 102, 103, or 112 must also be made.

Moreover, since the appellant has not defined the accessor and since the invention is directed to an apparatus, the processor unit 112 in Newell could be the accessor.

Office Action Response

The appellant states that the Office Action did provide some response to appellant's arguments on the § 102 rejections. Appellant states that most of the remarks related to defining which elements would not be considered structure, and thus apparently would be omitted from the rejection. Appellants submit that this approach is improper, particularly as the elements are proper as discussed above repeatedly. Appellants assert that even then the rejections are inconsistent with this improper approach. First, appellant asserts that the approach would not justify omitting most language in each element, which language was never mentioned as being improper. Yet this was done, as discussed above. Second, appellant asserts that the approach would not justify totally omitting elements never mentioned as being improper, as was done in the rejections of claims 5 and 8, as noted above. Thus, appellant asserts that the rejections are inconsistent even with the improper remarks, further reason for the rejections to be reversed. Applicants submit that the § 102 rejections are improper and must be reversed.

The Examiner respectfully disagrees with the appellant's assertions. The Examiner cited numerous rejections under 35 U.S.C. 112, 2nd paragraph and also provided the following statement leading into the rejection under 35 U.S.C 102:

The Examiner finds that because claim(s) 1-12 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the

Art Unit: 3629

art is applied *as much as practically possible*. As noted below, Applicant(s) are invited to contact the Examiner if additional assistance is needed.

The Examiner also provided the following to the appellant in the Office Action mailed on September 7, 2006:

The appellant argues that Newell is not related to recommending a decision in litigation and Newell does not disclose weighted values. Appellant's claim language is directed to a tool for developing litigation discovery material, a tool for recommending a decision and a tool for assessing a litigation. The Examiner asserts that since appellant states that the claimed invention is directed to an apparatus, then the data stored or input into the structure would be non-functional descriptive data, not functionally related to the structure of the invention. A data entry field would be an interface. The data displayed would not be functionally related to the structure. A menu is a display of data. The intended use of the menu is given little patentable weight if the apparatus or system of Newell is capable of having a menu. Storage is storage of data, generally a database. What is stored in the database is non-functional descriptive data. Form discovery materials are not considered to be structure. Weighted values are not considered to be structure.

Thus, the Examiner asserts that as appellant has claimed appellant's invention, Newell applies as prior art and appellant's claim language does not distinguish from the prior art.

Art Unit: 3629

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Janice A. Mooneyham/

Primary Examiner, Art Unit 3629

Conferees:

/Dennis Ruhl/

Primary Examiner, Art Unit 3629

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629